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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/780,507	01/08/1997	MARIA D. ELLUL	9427C	7164

7590 10/14/2003

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EXAMINER

REDDICK, MARIE L

ART UNIT PAPER NUMBER

1713

DATE MAILED: 10/14/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

08/780,507

Applicant(s)

ELLUL ET AL.

Examiner

Judy M. Reddick

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 07-25-03.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 20-24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 20-24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

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### DETAILED ACTION

#### Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114 was filed in this application after a decision by the Board of Patent Appeals and Interferences, but before the filing of a Notice of Appeal to the Court of Appeals for the Federal Circuit or the commencement of a civil action. Since this application is eligible for continued examination under 37 CFR 1.114 and the fee set forth in 37 CFR 1.17(e) has been timely paid, the appeal has been withdrawn pursuant to 37 CFR 1.114 and prosecution in this application has been reopened pursuant to 37 CFR 1.114. Applicant's submission filed on 07.25.03 has been entered.

2. Applicant's request filed on 07/25/03 for suspension of action in this application under 37 CFR 1.103(a), is acknowledged. However, a showing of good and sufficient cause for suspension of action has not been provided on this record and therefore, the Suspension request is herein being denied. Moreover, Applicant is herein apprised that the Office may grant a suspension of action only when there has been provided, on this record, good and sufficient cause.

#### Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 20-24 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. As far as the Examiner can tell, no support can be found for the recited limitation "having an ethylene content of at least 74%" per claim1 and this, as such, without any guidelines from applicant as to where support might be found, engenders a New Matter

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situation(see at least page 5, second paragraph, which teaches a C2 content greater than about 65 weight percent).

**Claim Rejections - 35 USC § 112**

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

A) The recited contents governing components (A) and (B) per claim 20 constitutes indefinite subject matter as per it not being readily ascertainable as to the exact entity that said contents are being based on, i.e., total thermoplastic elastomer composition or else.

B) The recited "having an ethylene content of at least 74%" per claim 20 and "an ethylene content between 74% and 77%" per claim 22 constitutes indefinite subject matter as per it not being readily ascertainable if the content is based on "wt." or "mol.".

C) The recited "Hoechst Grade G49M polypropylene, Hoechst Grade G53 polypropylene, Hoechst Grade G20/28 polypropylene" per claim 21 constitutes indefinite subject matter as per the use of Tradenames in the claims is improper. Where a trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of 35 U.S.C. 112, second paragraph. See *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. A trademark or trade name is used to identify a source of goods, and not the goods themselves. Thus, a trademark or trade name does not identify or describe the goods associated with the trademark or trade name. In the present case, the trademark/trade name is used to identify/describe polypropylene and, accordingly, the identification/description is indefinite.

**Claim Rejections - 35 USC § 103**

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6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

8. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

9. Claims 20-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Masuda et al (U.S. 5,525,675) in combination with Puydak et al (U.S. 5,100,947).

Masuda et al teach a thermoplastic elastomer comprising (A) 10-90 wt. % of polypropylene having substantially a syndiotactic structure, and (B) 90-10 wt. % of an ethylene-propylene-nonconjugated diene copolymer rubber and/or ethylene-propylene copolymer rubber, said (B) having been partially crosslinked, useful for obtaining formed products, particularly automotive bumper fascias, automotive mud guards and automotive trim skin material, which are excellent not only in flexibility, rubber elasticity and mechanical strength

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but also in external appearance and touch, and are substantially free from bleeding and fogging. Masuda et al further teach @ col. 3, lines 26-35 that syndiotactic polypropylene homopolymer usable in the present invention preferably has a syndiotactic pentad fraction of at least 0.7, notably at least 0.85 and that the homopolymer having a syndiotactic pentad fraction of at least 0.7 is preferred because of its excellent heat resistance and formability. Masuda et al, more specifically, teach @ col. 4, lines 9-31 that organic peroxide components, used as a crosslinking agent, is added in an amount of 0.1-3.0 parts by weight, preferably 0.2-1.0 part by weight per 100 parts by weight of the sum of the syndiotactic polypropylene and ethylene-propylene-nonconjugated diene copolymer rubber and/or ethylene-propylene copolymer rubber. Most importantly, Masuda et al state that if the amounts of organic peroxide are smaller than 0.1 part by weight, crosslinking of the component (B), that is, the ethylene-propylene-nonconjugated diene copolymer rubber and/or ethylene-propylene copolymer rubber is insufficient, leading to deteriorations in rubbery properties of resulting elastomer, such as strain recovery and impact resilience, and mechanical strength and on the other hand, amounts greater than 3.0 parts by weight cause not only a substantial reduction in the molecular weight of the syndiotactic polypropylene (A), which leads to a deterioration in the mechanical strength of the resulting thermoplastic elastomer, but also excessive crosslinking of the ethylene-propylene-nonconjugated copolymer rubber and/or ethylene-propylene copolymer rubber (B), which leads to a reduction in the flowability of the thermoplastic elastomer, and, as such, this necessarily translates to an implied teaching of "complete crosslinking". Although in the form of a negative teaching, all disclosures of the prior art, including unpreferred or auxiliary embodiments, must be considered in determining obviousness. In re Mills, 176 USPQ 196 (CCPA 1972); In re Lamberti, 192 USPQ 278; In re Boe, 148 USPQ 507. Masuda et al @ col. 5, lines 1-9 teach that the composition can contain one or more of various softeners including processing oil in order to impart improved flexibility and/or rubber elasticity to the thermoplastic elastomer, in an amount of not greater than 200 parts by weight/100 parts by

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weight of EPDM and/or ethylene-propylene copolymer rubber. See, e.g., the Abstract, cols. 2-5 and Run 5 of Masuda et al.

The disclosure of Masuda et al differs basically from the claimed invention in the content of ethylene per Run 5 amounting to 73 wt.% vs. the claimed ethylene content of "at least 74%". However, it would have been prima facie obvious in view of the close proximity between the ethylene content in the claimed invention and that described in Run 5 of Matsuda et al and the ethylene content and the resulting expectation that the compositions would have the same or substantially the same properties as provided for under the guise of *Titanium Metals Corp. v. Banner*, 778 F. 2d 775, 783, 227 USPQ 773, 779 (Fed. Cir. 1985). Specifically, the proportions are so close that prima facie one skilled in the art would have expected the ethylene copolymers to have the same properties.

The disclosure of Masuda et al further differs from the claimed invention as to no recognized specificity with respect to the "processing oil" (softener) and the absence of any guidelines to use as one of the commonly used adjuncts, an antioxidant. However, Puydak et al teach the commonality of using paraffin type process oils (sufficient to meet the claimed mineral oil per claim 23) and antioxidants (Irganox 1010, hindered phenolic antioxidant and sufficient to meet the limitations of claim 23) in ethylene-propylene copolymer and ethylene-propylene-diene terpolymer rubber compositions similar to those of Masuda et al and therefore, one having ordinary skill in the art would have found it obvious to use, a mineral oil as the processing oil and to add an antioxidant to the rubber composition of Masuda et al, following the guidelines of Puydak et al and with a reasonable expectation of success. See col. 6, lines 32-41, col. 11, lines 53-68, col. 12, lines 10-13 and col. 14, TABLES I - III of Puydak et al.

As to the properties such as "optically translucent" and "haze value", it would be expected that the composition of Masuda et al, as modified supra, would possess these properties since the composition of Masuda et al, as modified, is essentially the same as the claimed composition and in the absence of the USPTO to have at its disposal, the tools and facilities deemed necessary to make physical determinations of this sort. Moreover, the discovery that the

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claimed composition possess a property not disclosed for in the prior art does not alone defeat a prima facie case of obviousness as provided for under the guise of *In re Dillon*, 16 USPQ 2d. 1897-1921(CAFC 1990).

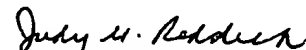
Conclusion


10. The prior art to Masuda et al(U.S. 4,212,787) is cited of interest in teaching the commonality of using mineral processing oils in thermoplastic elastomer compositions and is considered merely cumulative to the prior art supra.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Judy M. Reddick whose telephone number is (703)308-4346. The examiner can normally be reached on Monday-Friday, 6:30 a.m.-3:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on (703)308-2450. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)305-8183.

  
Judy M. Reddick  
Primary Examiner  
Art Unit 1713

JMR   
10.01.03